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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,285	06/26/2000	Vincent James Gatto	PM 268477	5162

7590

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

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13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/604285

Applicant(s)

GATTO et al

Examiner

MEDLEY

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 3-4-02

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 22-40, 42-55 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 22-40, 42-55 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☒ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

Office Action Summary

## DETAILED ACTION

Applicants' submission of the "Consent of Assignee" from parent Reissue Application 09/359,770, Paper No. 7, and dated March 5, 2002 has been made of record.

The examiner acknowledges applicants' statement that the Original Patent Grant was surrendered as evident from the paper dated November 6, 2000 in the parent reissue.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negative by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 22-40 and 42-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorsell et al (Thorsell) 4,648,985 combined with Applicants' admission in view of Louis de Vries et al (de Vries) 4,394,279 for reasons made of record in Paper No. 6 dated December 4., 2001.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thorsell et al (Thorsell) 4,648,985 combined with Applicants' admission in view of Louis de Vries et al (de Vries) 4,394,279 as applied to claims 22-40 and 42-54 above, and further in view of Hunt et al (Hunt) 4,832,857.

The difference between the references applied above and the instant claim is:

The above does not disclose the molybdenum complex produced by a reaction relied on prior art.

However, Hunt teaches that the molybdenum complex product-by-reaction process, column 4, lines 41 to column 5, lines 1-5, is old and conventional and that the reaction product is commercially acceptable for use in lubricating oil compositions.

It would be obvious to one of ordinary skill in the art to further modify the teachings of the above relied on prior art references as taught by Hunt wherein the molybdenum compound is phosphorus and sulfur free, and Thorsell would arrive at a lubricant having improved antioxidant and friction properties. It is noted on record that newly added claim 55 is substantially of the same scope as cancelled claim 41 except that applicant has excluded the sulfonate compound from claim 55.

It is further noted that the process limitations of claim 55 cannot impart patentability to a product, which is not patentably distinguished over the prior art. In re

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Thorpe et al (CAFC 1985) 771 F2d 695,227 USPQ 464; In re Dike (CCPA 1968) 394 F2d 584, 157 USPQ581; Tri-Wall Containers, Inc. v. U.S. (Ct. Cls. 1969) 408 F2d 748, 161 USPQ 117; In re Brown et al (CCPA 1972) 450 F2d 531, 173 USPQ 685; Ex parte Edwards et al (BPOAI 986) 231 USPQ 981.

Claims 22-54 are rejected under 35 U.S.C. 251, as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as stated in Paper No. 6 dated December 4, 2001.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 55 is indefinite and unclear for line 11 "resulting C," which may be overcome with the insertion of --- mixture --- before "C". In line 13, the phrase "said mixture" does not find support from line 11 or any other previous portion of said claim. In line 15 the term "of" after "filtration make the claim unclear." The term "or" may be used for the clarity of said claim. In the last line, the term "composition" is not supported by the term "compound" found in line 2 of the said claim.

Claim 55 recites the limitation "said mixture" in line 13. There is insufficient antecedent basis for this limitation in the claim.

Claim 55 recites the limitation "composition" in the last line. There is insufficient antecedent basis for this limitation in the claim.

Applicant's arguments filed March 4, 2002 have been fully considered but they are not persuasive.

The examiners' maintains the position that the new matter rejection stated in Paper No. 6 at pages 6 and 7 is proper with respect to claims 22-54. A careful review and study of claim 13 as presented in the original patent 5,560,381 states that it is directed to a "lubricating oil concentrate" wherein pending claims 22-40 and 42-54 is directed to a "lubricating composition". In the lubricant art it has been held that lubricant concentrates contain a much broader relative proportion of additives than the lubricant compositions. Thus claim 13 directed to a concentrate in original Patent 5,560,381 cannot be used as support for newly added claims 22-40 and 42-54 directed to a composition.

The examiner has reviewed applicants' argument presented in the first paragraph at page 4 of the amendment, Paper No. 9 dated March 22, 2002 with respect to claims 22-40 and 42-54. The examiner has reviewed and carefully studied the parent Patent 5,650,381 and notes that at column 3, lines 9-11, the following disclosure:

**"The compositions of this invention have various uses as lubricants such as for automotive and truck crank case lubricants as well as transmission lubricants".**

It is unclear to the examiner as to how that specific disclosure provides basis for the newly added claim 54 as follows:

Claim 54, A lubricated automotive or truck crankcase or transmission obtained according to claim 53.

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Claim 53, A method for lubricating an automotive or truck crankcase or transmission comprising adding a lubricating composition according to claim 22 or 23 to said crankcase or transmission.

In view of the above and in the absence of applicant pointing out the location in the parent patent the supporting basis for claim 54, the examiner maintains that the new matter rejection over claims 22-40 and 42-54 is proper.

In response to applicant's argument that de Vries requirement of carbon disulfide in its products preparation teaches away from the present pending claims of the Reissue application, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

A careful review of the instant claims indicate that the said claims does not exclude sulfur as being a reactant, and exclude sulfur as remaining active in the reaction product. A careful study of de Vries indicates that the sulfur reactant satisfy the valence of the molybdenum compound, column 2, lines 15-22, wherein the molybdenum compounds include carboxylic acid amide, etc, note claim 1. It appears that de Vries envision compounds free of active sulfur.

In response to applicant's argument that copper dithiocarbamates (Cu DTC) of Thorsell include active sulfur and thus teach away from the present claimed inventions, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when

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the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It is noted that applicants' claims contain the open-ended expression "comprising" and would not exclude Cu DTC. The three component system of Thorsell provides at least one of the component being free of phosphorus and free of active sulfur when the component (2) is molybdenum carboxylate and therefore meets the limitation of the instant claims.

Applicants' makes admission on record at columns 3 and 4 that molybdenum compounds which are substantially free of active sulfur are prepared from oil soluble molybdenum compounds and provides the laundry list of said compounds.

In response to applicant's argument that the adding of the Hunt reference would not make up for the short-comings in the art applied to claims 22-40 and 42-54, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

It is noted that Hunt 4,832,857 is one of the prior art listed by applicant at column 3 and 4 of the patent application as being their molybdenum compound. Hunt not only teaches overbased phenates and overbased salicylate, but also includes overbased sulfonates that appear to be the preferred compound. Thus the examiner maintains the Hunt reference and the art rejections based on the prior art are proper for reasons previously made of record.



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The Lowe reference will not be discussed at this time because the examiner did not use the Lowe reference in any of the art rejections of record.

Applicants' claims encompass a great number of reaction products, molybdenum carbonates and antioxidants, and a great number of amounts of these components, yet applicants have tested only one composition corresponding to their claimed invention. We find in the evidence of record no reasonable basis for concluding that the great number of materials encompassed by applicants' claims would behave as a class in the same manner as the particular materials tested. See *In re Linder*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *In re Susi*, 440 F. 2d 442, 445-46, 169 USPQ 423, 426 (CCPA 1971).

For the above reasons, we conclude, based upon the preponderance of the evidence that applicants' claimed invention would have been obvious to one of the ordinary skill in the art within the meaning of 35 USC 103.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310 and for after final 703-872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Margaret B. Medley  
Primary Examiner  
Art Unit 1714

M.B. Medley/dh  
June 25, 2002